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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/879,353	06/12/2001	Yasuhiro Toguri	09812.0574-00000	3903
22852	7590	09/07/2006	EXAMINER	
FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER LLP 901 NEW YORK AVENUE, NW WASHINGTON, DC 20001-4413			MANNING, JOHN	
			ART UNIT	PAPER NUMBER
			2623	

DATE MAILED: 09/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	09/879,353	TOGURI, YASUHIRO	
	Examiner John Manning	Art Unit 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_.  
 2a) This action is **FINAL**.                    2b) This action is non-final.  
 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1,2 and 5-25 is/are pending in the application.  
 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.  
 5) Claim(s) \_\_\_\_ is/are allowed.  
 6) Claim(s) 1,2, and 5-25 is/are rejected.  
 7) Claim(s) \_\_\_\_ is/are objected to.  
 8) Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.  
 10) The drawing(s) filed on \_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
 a) All    b) Some \* c) None of:  
 1. Certified copies of the priority documents have been received.  
 2. Certified copies of the priority documents have been received in Application No. \_\_\_\_.  
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                 | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                        | 5) <input type="checkbox"/> Notice of Informal Patent Application                        |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date ____ . | 6) <input type="checkbox"/> Other: ____ .  |

**DETAILED ACTION**

***Response to Arguments***

1. Applicant's arguments filed 6/16/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Applicant argues "[t]here would be no reason to register segment individual additional information which is associated with one of a plurality of segments of contents data and scene individual additional information associated with one of a plurality of scenes in contents data in the

system taught by Itakura, because Itakura does not contemplate scene or segment content." It is the examiners position that one of ordinary skill in the art at the time of the invention would have recognized the advantage of register segment individual additional information which is associated with one of a plurality of segments of contents data and scene individual additional information associated with one of a plurality of scenes in contents data as taught by Sezan in order to further personalize content specific to an individual, thereby enhancing the system functionality (See Paragraph 0006, Sezan).

Applicant has traversed the Official Notice of claims 1, 6, 8 and 16. Applicant has requested that a reference be cited in support of the Office Action's position that the simultaneous display of content data, general additional information and individual additional information recited in Applicants' claim was well known at the time of Applicants' claimed invention. The Examiner has added the previously cited Bedard (US Pat No 5,805,235) reference in the current Office Action in response to Applicant's rebuttal. The newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection. The Examiner has not relied on any other teachings in the reference. The newly cited reference is added for no other reasons other than to support the prior common knowledge statement.

Applicant argues, "Itakura does not disclose delivering advertisements (i.e. "contents data") together with extracted URLs (i.e. "general additional information") and extracted general individual information (i.e. user information such as sex, marriage,

occupation, etc., according to the Examiner's claim interpretation)." The examiner respectfully disagrees. The examiner interprets general additional information to be content ID and the individual additional information to be user information such as user ID). The URLs of Itakura are specific to both the content and the user. Since the URL is user specific the URL itself is individual additional information/user information.

Applicant states "[i]n addition, regarding claims 18, 19, and 21-25, the Examiner failed to address these claims in the Office Action, instead merely stating, 'With respect to claims 18-25, are by the limitations addressed for claim 1 (by virtue of the alternative language'. Applicant does not understand this statement." Applicant has (in the independent claims) claimed a plurality of types of "general additional information" in the alternative; the burden on the examiner is only to satisfy a single element. Claims 18, 19, 21-25 are further limiting upon the alternative "general additional information", which are not required for the independent claims. There is no burden on the examiner to meet furthering limiting dependent claims on items that were not addressed in the independent claims (because of the alternative language).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-2, 5-8, 10, 12, 14 and 16-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura (U.S. Patent No. 6,351,745) in view of Sezan et al. (US Pat Application Publication No 2005/0188328) and further in view of Bedard (US Pat No 5,805,235).

Itakura et al. teach a system used in a communication network that allows clients to access information Internet over a broadband connection as well as receive messages such as advertisements. User preferences are stored in a user database and advertisements are sent to users based on their preferences. A billing system is also taught to charge the advertiser based on the advertisements displayed to the user.

With respect to claims 1, 6, 8 and 16, Itakura teaches the claimed information processing apparatus. The claimed "first registration means for registering general additional information regarding said contents data" is met by Itakura's means to store data and identifying information. In column 8, lines 1-11 Itakura teaches storing data which represents the location of the data requested. This information may also include, for example, a home page address URL of a store on the world wide web. Because applicant has claimed a plurality of types of "general additional information" in the alternative, the burden on the examiner is only to satisfy a single element. Therefore, the claimed "contents ID" is met by storing in association an ID, such as the above noted URL. This is explicitly taught in column 8, lines 7-11. In this manner, Itakura meets the claimed first registration of "general information" regarding said contents data. The claimed "second registration of additional individual information..." is met by Itakura in the registering of client preferences in item S416 of figure 17. User

information such as sex, marriage status, occupation, etc. are stored in the message user database 34 of figure 6. Itakura also teaches that a transmittal condition database 36 can record additional individual information regarding goods that the user has already shown interest in, claimed "on the basis of at least said contents data," to ensure that suitable advertisements are sent according to user preferences in column 10, lines 48-58. The "individual information" is used to select the content data; therefore, there is a direct correlation between the two. As taught in column 10, lines 21-30, this database stores message URL's that identify each message and the corresponding transmission conditions. By using the user information to find proper messages, the message URL's are also "registered" for individual users based on preferences as "additional individual information," as claimed. The claimed storage means for storing said first and second registration information are thus met by the message user database 34 and the transmittal condition database 36. The stored general additional information and additional individual information is extracted using a characteristics reader used to retrieve characteristics from the databases as taught in column 27, lines 48-49. If a user is inactive, messages including general and individual additional information are not sent. Rather, only when "a delivery request for contents data" is received will the message distribution apparatus search and extract required information (col. 15: 13-42). The individual additional information "is extracted on the basis of user information comprising at least one of user status and user usage classification" by extracting based on user status, active or idle, and user characteristics, in order to accurately target active users. Furthermore, the claimed generation means for

generating individual data to be transmitted based on the general and individual additional information is met by the message distribution apparatus 39 of figure 1. Itakura teaches receiving a request for contents, followed by the reading of user preferences from said message user database 34 and transmittal condition database 36. The terminal 10 is the second information processing apparatus and the information provider 20 is the first information processing apparatus. Based on user preferences, messages as well as a URL relating to additional information are generated as taught in column 10, lines 31-58. The transmission means for transmitting said contents data, general additional information, and additional individual information is met by Itakura in column 11, lines 60-67 and column 12, lines 1-8. Itakura teaches an Internet connection with known communication method and message distribution apparatus 39 for distributing said individual data as messages to a terminal 10 of figure 1. Itakura fails to disclose "segment individual additional information which is associated with one of a plurality of segments of the contents data and scene individual additional information associated with one of a plurality of scenes in contents data". Sezan teaches "segment individual additional information which is associated with one of a plurality of segments of the contents data and scene individual additional information associated with one of a plurality of scenes in contents data" so as to efficiently determine content of potential interest to the user (See Paragraphs 0042, 0188 and 0190-0192; Figures 13 and 20). It clearly would have been obvious for one skilled in the art at the time to modify Itakura with teaches "segment individual additional information which is associated with one of a plurality of segments of the contents data and scene individual additional information

associated with one of a plurality of scenes in contents data" for the stated advantage. The combined teaching fails to disclose that said contents data, said general additional information and said individual additional information are simultaneously displayed on a display screen where contents data is delivered together with extracted information. Bedard teaches said contents data, said general additional information and said individual additional information to be simultaneously displayed on a display screen where contents data is delivered together with extracted information (See Fig. 3A-5C; Col 1, Line 18 – Col 2, Lines 4; Col 4, Lines 23-35). Looking to Figure 3A, the "Viewer: Bob" corresponds to the individual additional information, the "Now Playing: Larry King Live" corresponds to the general additional information, and the content displayed in the background corresponds to the contents data. It would have been obvious for one skilled in the art at the time of the invention to modify the combined teaching with said contents data, said general additional information and said individual additional information are simultaneously displayed on a display screen where contents data is delivered together with extracted information in order to provide the user with information regarding the watched program and user information, thereby making the system less complicated to the user.

With respect to claim 2, the claimed means for recording charging information on the basis of individual data generated is met by Itakura in the message access log 37 as seen in figure 12. Itakura teaches recording information regarding the access of said individual information data in column 1, lines 9-21.

With respect to claim 5, the claimed updating charging information by updating "charges to at least an end user for use of said contents data and/or individual metadata on the basis of said generated metadata" is taught in col. 10:59+ through col. 11: 8 by relieving a charge from a user based on a connection log. The connection log indicates what messages are recognized by a user and bills the message provider in order to relieve the user of their connection fee.

With respect to claim 7, the claimed recording medium wherein a program for controlling an information processing apparatus to deliver data over a network is taught by Itakura in the message manager 24. Itakura teaches message viewer software 76 of figure 3 to be installed on the terminal device in a recording medium in column 8, lines 43-67 and column 9, lines 1-3. Itakura further teaches that the recording medium can be a variety of devices such as RAM, DVD's, floppy disks, CD-ROM, tap media, semiconductor memory etc in column 25, lines 5-24. The software in the terminal device is used to communicate with message manager 24 of Figure 1 over the Internet. The message manager is taught to send and receive messages with the terminal as well as access databases. In this manner the message manager meets the claimed program because it controls the processing of all limitations. All other limitation are met by that addressed above for claim 1.

With respect to claims: 10, 12, and 14 are met by all of the limitations that are reflected in claim 1 as addressed above.

With respect to claim 17, Itakura teaches delivering messages and additional information to users based on their viewing history, as well as charging message

providers in response to the delivery of the messages. As noted above, Itakura teaches receiving a request for a message, followed by the reading of user preferences from said message user database 34 and transmittal condition database 36. Based on user preferences, characteristics including status, and usage history as seen in Figures 7, 8, and 9, claimed user status and classification, the messages suitable for individual viewers are generated. This general purpose additional information is displayed in the message viewer window 62 and as well ms a URL link through home page button 64. Although the specific term "metadata" is not used, the generation of individual metadata from general additional information and extracted additional information is taught. Examiner notes that applicant defines metadata as additional information that describes audio and video data on page 1, lines 18-21. This information is taken as commonly defined in the industry to include information such as name, size, data type, length, location, ownership, associations; and a number of other factors that describe contents data. All other limitation are met by that addressed above for claim 1.

With respect to claims 18-25, are by the limitations addressed for claim 1 (by virtue of the alternative language).

4. Claims 9, 11, 13, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itakura et al. (6,351,745) in view of Sezan et al. and further in view of Bedard (US Pat No 5,805,235) further in view of Kitsukawa et al. (6,282,713).

With respect to claims 9, 11, 13, and 15 neither Itakura nor Sezan explicitly teach splitting registration per object appearing within said contents data Examiner notes that the use of "hot spots" is well known in the art, and that these systems would read on

many of the limitations of claim 1. Hot spots are used to allow the viewer to obtain additional information regarding items in a display. A display is split per object based on items, claimed additional information, with additional individual information consisting of a URL link that provides additional information about the item appearing in within the display. To these means, Kitstzkawa et al. (6,282,713) teach an electronic advertising system utilizing hot spots to link users to additional information regarding displayed products. As seen in Figure 5, items containing additional information are separated per object and URL- information, claimed individual additional information, is registered for each item. As seen in Figure 4, item 410, a user may select an item, claimed "request," and as taught in column 7, lines 34-40 the 111 advertisement or web link may be displayed simultaneously with the regularly playing programming using well known picture in picture techniques. It would have been obvious for one skilled in the art at the time of the invention to further modify the techniques taught by Itakura and Sezan by splitting additional information per object as taught by Kitsukawa in order to provide additional information relating to multiple items displayed in a program that the user may have interest in.

### ***Conclusion***

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

Art Unit: 2623

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Manning whose telephone number is 571-272-7352. The examiner can normally be reached on M-F: 9:00 - 5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

JM  
August 31, 2006



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